Serial No. 09/525,247

REMARKS

Upon entry of the present Reply, claims 8, 9, 10, 12-14 and 21-55 are pending in the present application. Claims 11 and 15 are canceled herein, and new claims 51-55 are added herein. Claims 1-7 and 16-20 were previously canceled, and claims 10, 14 and 21-50 were previously withdrawn from consideration by the Examiner. Thus, only claims 8, 9, 12, 13 and new claims 51-55 are under consideration.

Applicants note that support for the amendments of claims 8 and 12, and for new claims 51-55, may be found for example, at page 24, line 28 to page 25, line 28, and at page 26, lines 6-20 of the application as filed.

Applicants respectfully request reconsideration of the application, withdrawal of the rejections, and allowance of the claims. Applicants respectfully submit that the claims are in condition for allowance and request notice to such effect.

Rejection of Claims 8, 9 11-13 and 15 Under 35 U.S.C. §102(e)

Claims 8, 9, 11-13 and 15 stand rejected as anticipated by Mizoguchi et al., U.S. Patent No. 6,593,841. Applicants traverse this rejection for at least the following reasons.

Claims 8, 9, 12 and 13:

Claims 11 and 15 have been canceled, thus rendering moot the rejection thereof.

With respect to claims 8, 9, 12 and 13, these claims have been amended to recite that, in the claimed lamination ceramic chip inductor, at least one conductive pattern is interposed between a pair of magnetic insulation layers so as to be in contact with the pair of magnetic insulation layers and so that the magnetic insulation layers contact one another in the area not in contact with the conductive pattern, in addition to the features that the at least one fine, continuous conductive pattern has a thickness of 10 µm or more and a width to thickness ratio from 1 to less than 5. One

advantage of this feature is that the laminated ceramic chip inductor includes a relatively small number of sheets. See, e.g., p. 12, lines 26-30 of the specification.

Applicants respectfully submit that Mizoguchi et al. does not include the feature that subsequent magnetic layers are in contact with each other in the area not in contact with the conductive pattern, as in the claimed invention. Applicants respectfully submit that Mizoguchi et al. is limited solely to a conductor separated from both magnetic sheets by an insulator layer. As shown in Figs. 5 and 6, in Mizoguchi et al., the magnetic layers 30A and 30B are separated from the conductive coil 40 by insulating layers 20B and 20C, which are composed of SiO₂ or polyaniline. See, e.g., Mizoguchi et al. at col. 31. lines 1-48 and Fig. 6. Mizoguchi et al. discloses a conductor separated from both magnetic sheets by an insulator layer, as shown, for example, in Figs. 5, 6, 7, 23 and 24 of Mizoguchi et al. For example, in Fig. 5, Mizoguchi et al. discloses that the magnetic layer 30A has formed thereon the layer 20B, the spiral planar coil 40 is mounted on the insulation layer 20B, and that the insulation layer 20C covers the coil 40, and the magnetic layer 30B is formed on the insulation layer 20C. Thus, the magnetic layer 30B is separated from the coil 40 by the insulation layer 20C, and the magnetic layer 30A is separated from the coil 40 by the insulation layer 20B. See, e.g., col. 10, lines 31-46 and Fig. 5.

Thus, Mizoguchi et al. fails to disclose the claimed features, in which at least one of the magnetic layers is in contact with the conductive coil, and in which the magnetic layers are in contact with each other in the area not in contact with the conductor, Mizoguchi et al. cannot anticipate the claimed invention.

Applicants respectfully submit that Mizoguchi et al. fail to disclose or suggest all the features of the presently claimed invention. Accordingly, Mizoguchi et al. cannot anticipate Applicants' claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of claims 8, 9, 12 and 13 over Mizoguchi et al.

New Claims 51-55:

With respect to newly submitted claims 51-55, these claims distinguish over Mizoguchi et al. for at least the same reasons set forth above with respect to claims 8, 9, 12 and 13, and for the following additional reasons.

With respect to claims 51, 52 and 55, as noted above, Mizoguchi et al. fails to disclose that the magnetic layers, e.g., layers 30A, 30B in Figs. 5 and 6, are in contact with the conductive pattern.

With respect to claim 53-55, these claims recite a greensheet consisting essentially of a plurality of ceramic chip inductors, and that the greensheet is formed by laminating together the ceramic chip inductors, which does not require the nascent ceramic chip inductors to be formed on a substrate, as required by Mizoguchi et al. As disclosed in Mizoguchi et al., see, e.g., Figs. 5 and 6 and the disclosure at col. 31, lines 6-48, and particularly line 6, the layers forming the Mizoguchi et al. device are formed on a silicon substrate. See also, col. 10, lines 33-46, wherein the layers of Fig. 5 are formed on a semiconductor substrate 10.

Thus, claims 51-55 distinguish over Mizoguchi et al. for all of the foregoing reasons. Since Mizoguchi et al. fails to disclose all the features of the invention claimed in claims 51-55, these claims are considered allowable thereover.

For all of the foregoing reasons, Applicants respectfully submit that the presently pending claims patentably distinguish over Mizoguchi et al. The Examiner is respectfully requested to reconsider and withdraw the rejection of Applicants' claims over Mizoguchi et al.

Conclusion

For the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance. Applicants submit that all indefiniteness issues have been addressed and overcome, and that all obviousness rejections should be withdrawn for the foregoing reasons.

YAMAP0347USB

Serial No. 09/525,247

In the event issues remain in the prosecution of this application, Applicants request that the Examiner telephone the undersigned attorney to expedite allowance of the application. Should a Petition for Extension of Time be necessary for the present Reply to the outstanding Office action to be timely filed (or if such a petition has been made and an additional extension is necessary) petition therefor is hereby made and, if any additional fees are required for the filing of this paper, the Commissioner is authorized to charge those fees to Deposit Account #18-0988, Docket No. YAMAP0347USB.

Two new independent claims and five total claims are added, and two dependent claims are canceled in this Reply. Accordingly, the Commissioner is hereby authorized to charge the additional fee (\$172 + \$54 = \$226.00) for two additional independent claims ($2 \times $86.00 = 172.00) and 3 additional total claims ($3 \times $18 = 54) to Deposit Account #18-0988, Docket No. YAMAP0347USB.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, P.L.L.

Date: February 26, 2004

Thomas W. Adams Reg. No. 35,047

1621 Euclid Avenue Nineteenth Floor Cleveland, Ohio 44115 (216) 621-1113

B:\Adams-Tom\Client Files\YAMA\347b\YAMA347B.ROA5_Feb04.wpd